

REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Original Claims 1-12 are presently active in this case, Claim 1 having been amended by the present amendment.

In the outstanding Office Action, Claims 1-3 and 5 were rejected under 35 U.S.C. §102(b) as anticipated by Kim (U.S. Patent No. 5,742,397); Claim 4 was rejected under 35 U.S.C. §103(a) as being unpatentable over Kim in view of Kawashima et al. (U.S. Patent No. 5,124,562, hereinafter called "Kawashima"); Claim 6 was rejected under 35 U.S.C. §103(a) as being unpatentable over Kim in view of Yamada et al. (U.S. Patent No. 5,323,016, hereinafter called "Yamada"); Claims 7 and 11 were rejected under 35 U.S.C. §103(a) as being unpatentable over Toida et al. (U.S. Patent No. 6,522,911, hereinafter called "Toida") in view of Kim; Claim 8 was rejected under 35 U.S.C. §103(a) as being unpatentable over Toida, Kim in view of Makosch et al. (U.S. Patent No. 4,298,283, hereinafter called "Makosch"); Claim 9 was rejected under 35 U.S.C. §103(a) as being unpatentable over Toida, Kim in view of Makosch; Claim 10 was rejected under 35 U.S.C. §103(a) as being unpatentable over Toida, Kim in view of Kawashima; and Claim 12 was rejected under 35 U.S.C. §103(a) as being unpatentable over Toida, Kim in view of Yamada.

In light of the outstanding grounds for rejection, Claim 1 has been amended to clarify the claimed invention and thereby more clearly patentably distinguish over the cited prior art. To that end, Claim 1 has been amended to clarify that when a loss of the intensity of light is detected, the specimen surface is fixed to a reference level.¹ In this process, it is not

¹ See the paragraph linking pages 13-14 of the specification for support of the amendment to Claim 1. No new matter has been added.

necessary to “measure the intensity of light” as disclosed in Kim. Only the detection of a loss of the intensity of light is necessary.

Kim teaches a process wherein “measuring,” and not “detecting” as presently stated in amended Claim 1, is the operative feature. By contrast, as the outstanding Office Action acknowledges in the Response to Arguments, page 2, lines 13-18, it is necessary, in Kim, to continuously detect the intensity of the reflected light for the adjustment to the specimen surface. It is respectfully submitted that the Kim process should be considered as requiring “measuring the intensity” rather than “detecting.” As a “measuring” step is avoided in the invention defined by amended Claim 1, it is respectfully submitted that Kim in no way anticipates or obviates the subject matter of Claim 1. As the secondary references are not seen to remedy the deficiency in Kim, it is respectfully submitted that the outstanding ground for rejection of Claim 1 and dependent Claims 2-6 dependent on Claim 1 have been overcome. Accordingly, withdrawal thereof is respectfully requested.

Similarly, pending Claim 7 includes the step of “fixing the level of the specimen surface to a reference level at the projected position corresponding to the recorded position information.” The outstanding Office Action at page 8, last paragraph, seems to rely on the disclosure at column 7, lines 33-53 as teaching the recited “fixing” feature of Claim 7. However, that portion of Kim merely states,

FIG. 7 is a graph illustrating a type of arrangement signal which passes through an arithmetic process after being outputted from the first and a second photoreceivers (11, 12). Its x-axis indicates a distance measured along the optical axis of a projection lens, while its y-axis indicates intensity of light. They can be obtained from the function of intensity distribution of arranged light as well as designated pixel. If a target is out of the fixed focus of a projection lens 100 or is sloped toward the optical axis, the value of the arrangement signal determined from a correlated function has a smaller value than the maximum value, whereas if a target is exactly on the fixed focus of a projection lens 100 or is not sloped, it has the maximum value.

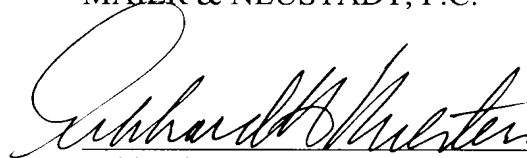
The control part 350 changes the position and slope of the support 200 by using a driving device 250 to drive the support 200 on which the target 300 is placed, and adjusts the value of the arrangement signal to the maximum value.

It is respectfully submitted that from the Kim disclosure it is not at all clear that the “arrangement signal” fixed to the “maximum value” has anything to do with “fixing the level of the specimen surface to a reference level at the projected position corresponding to the recorded position information,” as stated in Claim 7, and it appears to be hindsight speculation to suggest relevance of this passage of Kim to the “fixing” step of Claim 7. It is therefore respectfully submitted that Kim and the cited secondary references of record likewise fail to disclose or obviate this “fixing” step of Claim 7. Accordingly, it is respectfully submitted that the outstanding grounds for rejection of Claim 7 and dependent Claims 8-12 dependent on Claim 7 have also been overcome, and withdrawal thereof is respectfully requested.

Consequently, in view of the present amendment, and in light of the above clarification, the pending Claims 1-12 are believed to be in condition for formal allowance, and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Eckhard H. Kuesters
Attorney of Record
Registration No. 28,870

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)

EHK\la
I:\ATTY\EHK\24\S\243056US\243056US-AM.DOC